REMARKS

Applicants respectfully request reconsideration of the present application.

Claims 1-41 and 43-51 are pending in the present application. In the above amendments, claims 1, 5, 6, 11, 15, 16, 21, 25, 26, 31, 35, 36, 41, 46 and 47 have been amended. The currently recited subject matter of the independent claims was previously presented in original claims 5 and 6, 15 and 16, 25 and 26, 35 and 36, and 46 and 47. Thus, these claim amendments do not raise any new issues. Therefore, after entry of the above amendments, claims 1-41 and 43-51 will be pending in this application. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Amendments to the Specification

Applicants have amended the specification, as noted above, to correct a number of typographical errors. These amendments are fully supported throughout the specification, and do not introduce any new matter. Thus, Applicants respectfully request the Examiner to enter these amendments.

Claim Rejections – 35 USC § 103

Claims 1-41 and 43-51 are rejected under 35 USC § 103(a) as being obvious over McIntosh (U.S. Patent No. 6,169,799) in view of Bednarz *et al.* (U.S. Patent No. 4,490,583). Applicants have amended the claims, as noted above, to overcome this rejection.

The Examiner has failed to establish a *prima facie* case of obviousness for the claimed subject matter as: (1) there is no combination of the references that discloses or suggests the recited subject matter; and (2) the Examiner has not provided a factual basis supporting a motivation to modify McIntosh.

McIntosh and Bednarz, in any combination, do not disclose or suggest a method for

> transitioning the call, based on the new connection, from the first state to the second state, wherein transitioning further comprises transitioning between a clear state and a secure state

or an apparatus comprising an establisher that is

> configured to transition the call, based on the new connection, from the first state to the second state, wherein the establisher further transitions the call between a clear state and a secure state

as recited by the present claims.

Applicants respectfully submit that the Examiner's position that McIntosh discloses the recited clear state and secure state is erroneous. For example, the Examiner states that

> McIntosh further discloses the first state is a clear state (e.g. no match of number in memory) and the second state is a secure state (e.g. match of number in memory)(col. 3, line 45 – col. 4, line 46)…[and that] McIntosh further discloses the first state is a secure state (e.g. match of number in memory) and the second state is a clear state (e.g. no match of number in memory) (col. 3, line 45 – col. 4, line 46).[1]

The disclosure by McIntosh of a called number matching or not matching a number stored in memory does not having anything to do with transitioning a call between a clear state and a secure state. Further, McIntosh does not address or even suggest the use of a clear state and a secure state.

Additionally, Bednarz does not cure this deficiency of McIntosh, as Bednarz also fails to address or suggest the use of a clear state and a secure state.

[1] Final Office Action mailed November 2, 2006, page 5, lines 14-19.

Thus, in any combination, McIntosh and Bednarz fail to disclose or suggest the recited method and apparatus that transition a call, based on a new connection, from a first state to a second state, wherein the transition is between a clear state and a secure state.

Further, both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation or suggestion in the prior art to do so.[2] The PTO can satisfy this burden only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references.[3] Further, it is well settled that the mere fact that the prior art *could be* modified does not make the modification obvious unless the prior art has suggested the desirability of the modification.[4]

In the Office Action, the Examiner merely states that the recited subject matter is obvious in light of the cited references.[5] The Examiner does not provide any factual basis of any suggestion in the prior art to modify an invention dealing with problems associated with dialing 10 digit area codes with an invention dealing with the problems of expensive and complicated telephone control systems for receiving or placing calls from a number of different telephones using any one of a limited number of telephone lines from a central office or PBX. Only through the improper use of hindsight has the Examiner been able to coble together the cited references. Thus, the Examiner's lack of providing factual information for making the alleged combination comprises an insufficient showing of motivation.

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[2] *See also, Pfizer v. Apotex, Docket No 06-1261, (Fed. Cir. 2007); In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).
[3] *Id.*
[4] *In re Gordon* (emphasis added).
[5] *See, e.g.,* Final Office Action at p. 3, lines 13-18.

Therefore, based on the above remarks, Applicants respectfully request that the Examiner withdraw the rejection of 1-41 and 43-51 under 35 USC § 103(a) as being obvious over McIntosh in view of Bednarz.

CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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